

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: December 7, 2022

Mailed: January 5, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re International Fruit Genetics, LLC*  
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Application Serial No. 88710987  
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Kimberlee A. Boyle of Richard Law Group, Inc.,  
for International Fruit Genetics, LLC.

Justin Moscati, Trademark Examining Attorney, Law Office 127,  
Mark Pilaro, Managing Attorney.

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Before Bergsman, Wolfson, and Lebow,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

International Fruit Genetics, LLC (“Applicant”) seeks registration on the Principal Register of the mark COTTON CANDY (in standard characters) for the goods listed below:

Preserved, dried and cooked fruits and vegetables; jellies, jams and compotes; milk and milk products, namely, flavored milk, yoghurt, and cream, in International Class 29;

Confectionary, namely, chewy sweets, chocolate confections, boiled confectionery made of sugar, hard confectionery made of sugar, jelly confections, lollipops; sherbet and sour lollies, toffee; sorbet; edible ices;

seasonings; spices; sauces; condiments for food and drink being ketchup, mustard, barbeque sauce, and mayonnaise; custard, in International Class 30;

Beers; non-alcoholic carbonated and non-carbonated beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups for beverages; other non-alcoholic preparations for making beverages, namely, non-alcoholic fruit extracts used in the preparation of beverages, in International Class 32; and

Preparations for making alcoholic beverages, namely, alcoholic and non-alcoholic flavorings and essences for making alcoholic beverages, in International Class 33.<sup>1</sup>

The Examining Attorney refused to register Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that "Cotton Candy" describes the flavor of the goods. The flavor of food products has been held merely descriptive of such food products. *In re Andes Candies Inc.*, 478 F.2d 156, 178 USPQ 156 (CCPA 1973) (holding CRÈME DE MENTHE merely descriptive of laminated chocolate mint candy squares); *In re Int'l Salt Co.*, 171 USPQ 832 (TTAB 1971) (holding CHUNKY CHEESE merely descriptive of cheese-flavored salad dressing). *See also A. J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364

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<sup>1</sup> Application Serial No. 88710987 was filed on November 30, 2019, for the above-identified goods under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's asserted bona fide intention to use the mark in commerce.

Applicant also applied to register COTTON CANDY "fresh fruits and vegetables; grape vines, plants and plant propagating material," in International Class 31. However, pursuant to Applicant's May 24, 2021 Request to Divide, those goods were transferred to a separate application (Serial No. 88984471).

When we cite to the prosecution history of the application, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf version. When we cite to the briefs, we refer to TTABVUE, the Board's online docket system.

(3d Cir. 1986) (holding CHOCOLATE FUDGE generic for chocolate fudge flavored diet soda).

The Examining Attorney also refused to register Applicant's mark for the goods in Class 30 – "Confectionary, namely, chewy sweets, chocolate confections, boiled confectionery made of sugar, hard confectionery made of sugar, jelly confections, lollipops; sherbet and sour lollies, toffee; sorbet; edible ices; seasonings; spices; sauces; condiments for food and drink being ketchup, mustard, barbeque sauce, and mayonnaise; custard" – under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the two registered marks listed below, owned by different entities, as to be likely to cause confusion:

- Registration No. 2638407 on the Principal Register for the mark COTTON CANDY and design reproduced below for "bubble gum," in International Class 30;<sup>2</sup> and



- Registration No. 2976094 on the Principal Register for the mark COTTON CANDY (standard characters) for "ice cream," in International Class 30.<sup>3</sup>

For the reasons discussed below, we affirm both refusals.

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<sup>2</sup> Registered October 22, 2002; second renewal.

<sup>3</sup> Registered July 26, 2005; renewed.

## I. Preliminary Issues

Before proceeding to the merits of the refusal, we address three preliminary matters.

### A. Whether Applicant claimed that COTTON CANDY for the applied-for goods in International Classes 29, 30, 32, and 33 acquired distinctiveness

Applicant argues that it “owns many U.S. Trademark registrations for its live plants and fresh fruit, including but not limited to registrations for COTTON CANDY for live plants, namely, grape vines (RN 4007539), in use since at least as early as 2010 and COTTON CANDY for fruits, namely fresh grapes (RN 4109691) used [sic], in use since at least as early as 2011,” and that “[t]hese prior registrations and Applicant’s use of the COTTON CANDY mark in commerce for over a decade have resulted in Applicant’s COTTON CANDY mark acquiring distinctiveness.”<sup>4</sup>

Applicant also argues that the products identified in the description of goods will have the same flavor profile as its COTTON CANDY grapes, and will be sold using the same product trade dress. Thus, “[i]t will be apparent that the COTTON CANDY

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<sup>4</sup> October 4, 2021 Request for Reconsideration, p. 4 (TSDR 9).

Registration No. 4007539 for the mark COTTON CANDY (standard characters) for “live plants, namely, grape vines,” in International Class 31, was registered on the Principal Register without a claim of acquired distinctiveness on May 6, 2012, and has been renewed.

Registration No. 4109691 for the mark COTTON CANDY (standard characters) for “fruits, namely, fresh grapes,” in International Class 31, was registered August 2, 2011, was registered on the Principal Register without a claim of acquired distinctiveness and has been renewed.

mark is a source indicator of Applicant's goods that are sufficiently similar and related to those identified in the subject application."<sup>5</sup>

Despite making a general claim that its use and prior registration of COTTON CANDY for live plants and fresh fruits have resulted in acquired distinctiveness, Applicant did not claim that its proposed mark has acquired distinctiveness with respect to the applied-for goods.<sup>6</sup> For example, in the procedural history section of its brief, Applicant did not claim that its COTTON CANDY mark for the applied-for goods has acquired distinctiveness.<sup>7</sup> In fact, Applicant did not identify acquired distinctiveness as an issue in its appeal brief.

Applicant filed a Notice of Appeal on May 24, 2022. The issues on appeal are whether the mark COTTON CANDY is merely descriptive of all of Applicant's goods in Classes 29, 30, 32 and 33 and whether the COTTON CANDY mark is likely to cause confusion with the cited marks in Class 30.<sup>8</sup>

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<sup>5</sup> *Id.*

<sup>6</sup> October 4, 2021 Request for Reconsideration, p. 4 (TSDR 9).

<sup>7</sup> Applicant's Brief, pp. 3-7 (4 TTABVUE 4-8).

<sup>8</sup> *Id.* at p. 7 (4 TTABVUE 8). The concurring opinion points to the Examining Attorney's decision to approve Applicant's divided-out Class 31 goods for publication as indicating his belief that Applicant is claiming acquired distinctiveness of COTTON CANDY with respect to the involved goods. However, as he explains in his final office action and the portion thereof quoted in the concurring opinion, the Examining Attorney believed the USPTO was estopped from refusing registration of an identical mark for identical goods. *See* November 24, 2021 Office Action (TSDR 10). Thus, contrary to assertions in the concurring opinion, e.g., footnote 53, the Examining Attorney did not understand that Applicant was making a claim, in the alternative, that its mark has acquired distinctiveness. Rather, as he observes in his brief, "[f]irst, it is noted that applicant has not made a claim of acquired distinctiveness. ... Applicant has made no such claim and has also made no attempt to demonstrate that any distinctiveness would transfer to applicant's goods." (6 TTABVUE 8).

Throughout prosecution, the Examining Attorney consistently stated the issue in this application was whether Applicant's mark is merely descriptive without referring to acquired distinctiveness. In the November 24, 2021 Denial of Request for Reconsideration (TSDR 2), the Examining Attorney maintained and made final the refusal to register Applicant's

Moreover, upon questioning by the Board at the oral hearing, Applicant expressly confirmed that it does not claim, in the alternative, that COTTON CANDY had acquired distinctiveness for the specific goods at issue in this application. Accordingly, we find that Applicant did not claim that its mark has acquired distinctiveness with respect to those goods, and we do not analyze whether Applicant's mark COTTON CANDY has acquired distinctiveness for those goods.

**B. List of third-party registrations**

Applicant, in its July 6, 2021 and October 4, 2021 Responses to Office Actions, lists 17 third-party registrations by registration number, mark, and goods.<sup>9</sup> Applicant, in its brief, refers to the same list of registrations, marks, and goods.<sup>10</sup>

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COTTON CANDY mark under Section 2(e)(1) of the Trademark Act on the ground that COTTON CANDY for the applied-for goods is merely descriptive. The Examining Attorney identified the pending issues as follows:

SUMMARY OF ISSUES MADE FINAL that applicant must address:

- Section 2(e)(1) Refusal In Part – Merely Descriptive
- Section 2(d) Refusal In Part International 030 – Likelihood of Confusion

*Id.* He did not refer to any purported claim that Applicant's mark has acquired distinctiveness under Section 2(f) of the Trademark Act. Subsequently, in his appeal brief, the Examining Attorney identified the issues as whether Applicant's mark is merely descriptive and whether there is a likelihood of confusion with respect to the applied-for goods in International Class 30. Examining Attorney's Brief (6 TTABVUE 3). As noted above, the Examining Attorney expressly stated, in his brief, that Applicant did not make a claim that its mark acquired distinctiveness.

<sup>9</sup> July 6, 2021 Responses to Office Actions (TSDR 8) and October 24, 2021 Response to Office Action (TSDR 9-10).

<sup>10</sup> Applicant's Brief, p. 13 (4 TTABVUE 14).

The Examining Attorney, in his brief, objects to the list of registrations, marks, and goods on the ground that providing a list of marks does not make them of record. To make third-party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (2022); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 710.03 (2022).

However, as noted in the TBMP, there are limited circumstances where the Board will consider a list of registrations.

In particular, if an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have waived any objection to consideration of the list itself, for whatever probative value it may have.

TBMP § 1208.02 (citing *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in continuing a refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (“[T]he examining attorney’s failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... ‘for whatever limited probative value such

evidence may have,” (citing *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff’d*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013)); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 (TTAB 2011) (specific data provided by applicant considered because examining attorney did not advise applicant that a listing of registrations was insufficient when applicant had time to cure the defect)). *See also* TMEP § 710.03 (“If the applicant’s response includes improper evidence of third-party registrations, the examining attorney must object to the evidence in the first Office action following the response. Otherwise the Board may consider the objection to be waived.”).

Notably, in the July 20, 2021 and November 24, 2021 Office Actions following Applicant’s submissions of the list of third-party registrations, the Examining Attorney failed to advise Applicant that it improperly submitted a list of registrations rather than submit copies of the registrations. Instead, in his November 24, 2021 Office Action, the Examining Attorney acknowledged Applicant had submitted third-party registrations.<sup>11</sup> Because the Examining Attorney failed to advise Applicant that it improperly submitted a list of third-party registrations when Applicant had time to correct the error, we overrule the Examining Attorney’s objection to the list of registrations and we will consider the list for whatever probative value it has.

### **C. Late-filed evidence**

Applicant, in its brief, submitted the evidence listed below for the first time:

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<sup>11</sup> November 24, 2021 Office Action (TSDR 4).

- Copies of webpages from the Spangler Candy website (spanglercandy.com/chewy-candy-category/all);<sup>12</sup>
- A link to the Wikipedia.org entry for chewing gum;<sup>13</sup> and
- A link to the Wikipedia.org entry for dairy intolerance.<sup>14</sup>

The Examining Attorney objects to this evidence as untimely. The record in an application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d).

With respect to the copy of the webpages from the Spangler Candy website, Applicant points out that the Examining Attorney “initially introduced a page from the Spangler candy website in his November 24, 2021 Office Action [TSDR 11].”<sup>15</sup>

Applicant respectfully submits that its Appeal Brief’s use of the Spangler candy website as a resource and reference in response to the Examining Attorney’s introduction of a page from the same website should be permitted, aligned with the approach in *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986) (when an examiner makes excerpts from an article a matter of record in a final office action and an applicant includes more extensive excerpts of the same article in its brief, it is fair for the Board to consider the applicant’s included excerpts on the premise that “by citing only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came.”)[.] TBMP 1207.01 n.1.<sup>16</sup>

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<sup>12</sup> Applicant’s Brief, pp. 16-17 and Exhibit A (4 TTABVUE 17-18 and 23-25).

<sup>13</sup> Applicant’s Brief, p. 17 n.2 (4 TTABVUE 18).

<sup>14</sup> Applicant’s Brief, p. 18 n.3 (4 TTABVUE 19).

<sup>15</sup> Applicant’s Reply Brief, p. 3 (7 TTABVUE 4).

<sup>16</sup> Applicant’s Reply Brief, pp. 3-4 (7 TTABVUE 4-5).

TBMP §§ 1207.01 and 1208.01 explain that “if the applicant or the examining attorney submits excerpts from articles during examination, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed” (citing *Bed & Breakfast Registry*, 229 USPQ at 820 (if only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came and, therefore, the Board may consider more extensive excerpts from Nexis articles applicant submitted with its brief)).

TBMP § 1208.01 further notes that “[i]f the nonoffering party wishes to have the entire article considered, the better practice is to submit the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief, the Board need not remand the application, and may instead consider the article as part of the record.” Likewise, Applicant argues that because the Examining Attorney had the opportunity to review the entire Spangler Candy website before submitting the specific webpage he made of record, the Board should consider the webpage submitted with the appeal brief as part of the record.<sup>17</sup> Analogizing webpages to an excerpt from an article, Applicant contends the webpage submitted by the Examining Attorney should not be insulated from the context from whence it came because the late-filed webpage submitted by Applicant with its brief provides context for the Examining Attorney’s evidence.<sup>18</sup>

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<sup>17</sup> Applicant’s Reply Brief, p. 3 (7 TTABVUE 4).

<sup>18</sup> *Id.* at pp. 3-4 (7 TTABVUE 4-5).

In this case, the webpage Applicant submitted came from a different section of the website and it did not provide context for the webpage the Examining Attorney submitted. The Examining Attorney submitted a webpage derived from the menu category “lollipop” to show that Applicant’s mark COTTON CANDY is a flavor and, therefore, merely descriptive. Applicant, however, submitted a webpage derived from the menu category “chewy candy” to show that chewy candy does not include bubble gum and, therefore, with respect to the likelihood of confusion refusal, the goods at issue are not related. The webpage Applicant submitted from a different section of the website is analogous to submitting two articles from the same database. In addition, because Applicant submitted a different webpage for a different purpose than the webpage the Examining Attorney submitted, the Examining Attorney did not necessarily have the opportunity or reason to encounter the webpage Applicant submitted.

Because Applicant submitted a Spangler Candy Company webpage for “chewy candy” for the first time in its brief, from a different section of the website, that webpage does not provide context for the Spangler Candy Company webpage the Examining Attorney submitted, we do not find the exception to admissibility set forth in *Bed & Breakfast Registry* to be applicable. Therefore, we sustain the objection to the copy of the webpages from the Spangler Candy website Applicant submitted with its brief.<sup>19</sup>

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<sup>19</sup> In this decision, we only decide that the webpage Applicant submitted does not fall within the *Bed & Breakfast Registry* exception to admitting late-filed evidence. We do not decide whether the holding in *Bed & Breakfast Registry* in general may be expanded to include

With respect to the links to entries posted on Wikipedia.org, providing only the link without the material attached is not sufficient to introduce it into the record. *In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017) (“Because the information displayed at a link’s Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record.”); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1462 n.8 (TTAB 2017) (providing only a web address or hyperlink is insufficient to make such materials of record). We therefore sustain the objection to the links to the entries posted on Wikipedia.org and will not consider Applicant’s assertions based on that evidence.

## **II. Whether COTTON CANDY is merely descriptive**

### **A. Applicable Law**

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them,” unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).

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websites or the circumstances under which it may include websites. We leave that to a case with a more fully developed record on that issue.

“A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services.” *In re Fallon*, 2020 USPQ2d 11249, at \*7 (TTAB 2020) (quoting *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018) (citing *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012)); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015); and *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978)). “A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

Moreover, “a mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods] for which registration is sought.’” *Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). Accordingly, the Examining Attorney need only show that the proposed mark is merely descriptive of one of the products listed in each class in the application.

“Whether a mark is merely descriptive is ‘evaluated in relation to the particular goods for which registration is sought, the context in which it is being used, and the

possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use,” *Fallon*, 2020 USPQ2d 11249, at \*7 (quoting *Chamber of Commerce*, 102 USPQ2d at 1219) (internal quotation omitted)), and “not in the abstract or on the basis of guesswork.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513) (citing *Abcor Dev.*, 200 USPQ at 218). “We ask ‘whether someone who knows what the goods and services are will understand the mark to convey information about them.’” *Id.* (quoting *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *Id.* (citing *Fat Boys*, 118 USPQ2d at 1515).

Applicant’s proposed marks consist of the words “Cotton” and “Candy.” “We must ‘consider the *commercial impression* of a mark as a whole.’” *Id.* (quoting *Real Foods*, 128 USPQ2d at 1374).

“Whether a mark is merely descriptive or not is determined from the viewpoint of the relevant purchasing public.” *Id.*, at \*5 (quoting *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1090 (Fed. Cir. 2005) (internal quotation omitted)). Thus, our analysis focuses on the viewpoint of consumers who purchase such products.

“Evidence of the public’s understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in

dictionaries, trade journals, newspapers[,] and other publications.” *Fallon*, 2020 USPQ2d 11249, at \*7 (quoting *Real Foods*, 128 USPQ2d at 1374). “These sources may include [w]ebsites, publications and use in labels, packages, or in advertising materials directed to the goods [or services].” *Id.*, at \*7-8 (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (internal quotation omitted)). “Evidence that a term is merely descriptive similarly may come from an applicant’s own usage other than that found on its labels, packaging or advertising materials.” *Omnioime*, 2020 USPQ2d 3222, at \*4.

“It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services.” *Fallon*, 2020 USPQ2d 11249, at \*8 (quoting *Fat Boys*, 118 USPQ2d at 1513). “If such a showing is made, the burden of rebuttal shifts to the applicant.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513). “The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513).

## **B. Evidence**

We start our evidentiary review by defining “Cotton Candy.” The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed November 29, 2022) defines “Cotton Candy,” inter alia, as “a candy made of spun sugar.”<sup>20</sup> Thus, “Cotton Candy”

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<sup>20</sup> The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

is a unitary term with a distinct meaning separate and apart from its components “Cotton” and “Candy.”

We list below the other evidence the Examining Attorney submitted to support his contention that “Cotton Candy” is a unitary term:

- An excerpt from the Urban Vines Winery & Brewing Co. website (urbanvines.com) advertising Carnival Candy wine: “Carnival Candy: Taste Like Cotton Candy!”<sup>21</sup> We reproduce below an excerpt from the webpage:



**Carnival Candy: Taste Like Cotton Candy!**

Our popular cotton candy flavored wine is made with grapes from the Great Lakes growing region. The wine is slowly fermented to keep the natural cotton candy flavor of these grapes.

Wine Type: Sweet White  
ABV: 11.0%  
Size: 750mL  
Residual Sugar (R.S.): 7.0%  
Varietal: White Blend  
Fruit Location: Western New York  
Pairings: Pork and Poultry Dishes  
How to Drink: Cold



- Amazon.com webpage advertising the sale of Le Lupo de Monin Blue Cotton Candy flavored syrup for snow cones.<sup>22</sup>

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<sup>21</sup> January 4, 2021 Office Action (TSDR 6).

<sup>22</sup> January 4, 2021 Office Action (TSDR 8).

- A copy of a webpage from the Blair Candy website (blaircandy.com) advertising cotton candy flavored bubble gum;<sup>23</sup>
- A copy of the Cotton Candy webpage from the Baskin Robbins website (baskinrobbinsathome.com) advertising Cotton Candy ice cream.<sup>24</sup>

### **Cotton Candy**

Your favorite fluffy carnival treat is now your new favorite ice cream! Colorfully creamy and dreamy, our Cotton Candy flavored ice cream has all of the festive flavor we know you'll love.<sup>25</sup>

- An excerpt from the Target website (target.com) advertising the sale of Yoplait Cotton Candy Yogurt;<sup>26</sup>
- A copy of The Dairy Alliance Facebook webpage featuring Cotton Candy flavored milk.<sup>27</sup>

The Dairy Alliance

September 30, 2019

Cotton Candy Flavored Milk?! Borden Dairy is celebrating the State Fair of Texas with new flavored milks such as Cotton Candy, Banana Taffy and Blueberry Cobbler. These fun flavors can be found at select retailers in Texas, Mississippi, Louisiana and Alabama.

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<sup>23</sup> January 4, 2021 Office Action (TSDR 9-10).

<sup>24</sup> January 4, 2021 Office Action (TSDR 11). *See also* November 24, 2021 Office Action (TSDR 14) (“A swirl of pink & purple cotton candy ice cream.”).

<sup>25</sup> January 4, 2021 Office Action (TSDR 11).

<sup>26</sup> January 4, 2021 Office Action (TSDR 12). *See also* the Yoplait website (yoplait.com) advertising Cotton Candy & Strawberry yogurt. November 24, 2021 Office Action (TSDR 12).

<sup>27</sup> January 4, 2021 Office Action (TSDR 13).

- An excerpt from the Amoretti website (amoretti.com) advertising Cotton Candy extract.<sup>28</sup> “Amoretti Cotton Candy” is a water-soluble extract used in culinary applications to provide “the delicious flavor of sweet, freshly-spun cotton candy straight into all your favorite culinary applications.”<sup>29</sup>

- An excerpt from the Walmart website (walmart.com) advertising “Clear American Cotton Candy Sparkling Water;”<sup>30</sup>

- An excerpt from the Spangler Candy website (spanglercandy.com) advertising Dum-Dum Cotton Candy flavored lollipops.<sup>31</sup>

Cotton Candy is a new favorite ... kids tells us they love it.

It was added to the flavor assortment in 2002!<sup>32</sup>

#### **D. Analysis**

COTTON CANDY is a unitary term identifying spun sugar candy. Consumers perceive COTTON CANDY having a distinct flavor as shown by third parties advertising their foods and beverages with COTTON CANDY flavor (e.g., Carnival Candy wine that tastes like cotton candy, cotton candy flavoring extracts, cotton candy ice cream, etc.). As noted above, flavors have been held to be merely descriptive of food products. As the court held in *Andes Candies*,

We think the only possible reaction of purchasers, upon being presented with CREME DE MENTHE chocolate wafers, is the expectation that the wafers will have a mint

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<sup>28</sup> November 24, 2021 Office Action (TSDR 9).

<sup>29</sup> *Id.*

<sup>30</sup> November 24, 2021 Office Action (TSDR 10).

<sup>31</sup> November 24, 2021 Office Action (TSDR 11).

<sup>32</sup> *Id.*

taste something like that of creme de menthe liqueur. Surely, the purchasers would not expect to find a cherry or rum or butterscotch flavor in the candies. ...

Appellant argues that its mark only *suggests* a flavor similar to that of the liqueur. If that were so, registration would be proper. We think however that the mark *demand*s that, and only that, flavor. ... It is sufficient to preclude registration that the mark merely describes the flavor characteristic.

178 USPQ at 157 (emphasis added). Likewise, the most obvious reaction of purchasers encountering COTTON CANDY for the products in Applicant's description of goods is the expectation that those products will taste like cotton candy.

Applicant contends that it is "a breeder of fruit, specifically table grapes and cherries" that have a "uniquely toffee/caramel flavor."<sup>33</sup>

This is an important distinction. Applicant's COTTON CANDY table grapes are *not* literally flavored like the spun sugar, candy floss concoction of carnivals and state fairs. Instead, Applicant's COTTON CANDY grapes' toffee/caramel flavor suggests the smell of the caramelization that results from the process of heating and liquefying sugar.<sup>34</sup>

As discussed above, Applicant owns registrations for COTTON CANDY for grape vines and fresh grapes. "These prior registrations and Applicant's use of the COTTON CANDY mark in commerce for over a decade have resulted in Applicant's COTTON CANDY trademark acquiring distinctiveness."<sup>35</sup> According to Applicant, the applied-for products will feature this toffee/caramel flavor.

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<sup>33</sup> Applicant's Brief, p. 11 (4 TTABVUE 12).

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* As noted above, Applicant's prior registrations for COTTON CANDY for grape vines and fresh grapes are registered on the Principal Register without a claim of acquired distinctiveness. We also note that Applicant did not submit any evidence regarding the

Applicant intends that the [applied-for] products in varying degrees appropriate for a given item will carry the toffee/caramel flavor profile of its grapes and/or include actual grapes or grape juice and in addition could be grape-colored and shaped (reminiscent of the shape and color of Applicant's fresh COTTON CANDY grapes), and/or could feature images of the same-named grapes on the product packaging. This type of "ingredient/flavor branding" ultimately allows the end consumer who is familiar with the same-named fresh fruit to recognize the brand in the licensed products and recognize the mark as a source indicator.<sup>36</sup>

Applicant concludes that consumers will perceive the mark as being suggestive because its COTTON CANDY products are not the "common flavor' of the spun, sugar candy floss concoction of carnivals and state fairs."<sup>37</sup>

Applicant's argument does not persuade us that COTTON CANDY as applied to the products in its description of goods is anything other than merely descriptive. Applicant's arguments are based on the unsupported assumption that consumers will associate COTTON CANDY products in the applied-for classes with Applicant's distinct toffee/caramel flavor. However, as noted above, the issue of whether a mark is merely descriptive is evaluated, *inter alia*, in relation to the particular goods for which registration is sought. *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at \*5 (TTAB 2022) (quoting *Fallon*, 2020 USPQ2d 11249, at \*7) (quoting *Chamber of Commerce*, 102 USPQ2d at 1219). *See also* Section 2(e)(1) of the Trademark Act, 15

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strength of its COTTON CANDY mark for grape vines or fresh grapes to support its contention that its mark has acquired distinctiveness or that its grapes have become known for their toffee/caramel taste.

<sup>36</sup> Applicant's Brief, p. 12 (4 TTABVUE 13).

<sup>37</sup> Applicant's Brief, pp. 13-14 (4 TTABVUE 14-15).

U.S.C. § 1052(e)(1) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . . .”). Applicant’s descriptions of goods have no restrictions or limitations associating the products with the distinctive taste of Applicant’s grapes, or require that the goods be grape-colored or grape-shaped, or have toffee/caramel-flavored grapes as a required ingredient.

In analyzing whether a mark is merely descriptive, “[w]e ask ‘whether someone who knows what the goods and services are will understand the mark to convey information about them.’” *Fallon*, 2020 USPQ2d 11249, at \*7 . (quoting *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 128 USPQ2d at 1374 (quoting *DuoProSS*, 103 USPQ2d at 1757). When a consumer encounters Applicant’s foods, beverages, and preparations for making beverages identified by the mark COTTON CANDY, the consumer will understand that the products taste like COTTON CANDY. For example, when a consumer encounters COTTON CANDY in connection with yoghurt in Class 29, chewy sweets in Class 30, fruit beverages in Class 32, or non-alcoholic flavorings for make alcoholic beverages in Class 33, the consumer expects those products will be cotton-candy flavored. There is nothing in the description of goods that associates the applied-for products with Applicant’s grapes or the distinctive taste of its grapes.

We find that Applicant's mark COTTON CANDY is merely descriptive of the goods identified in the application.

### **III. Likelihood of Confusion**

As noted above, the Examining Attorney also cited the registered marks listed below as bars to the registration of Applicant's mark COTTON CANDY for "confectionary, namely, chewy sweets, chocolate confections, boiled confectionery made of sugar, hard confectionery made of sugar, jelly confections, lollipops; sherbet and sour lollies, toffee; sorbet; edible ices; seasonings; spices; sauces; condiments for food and drink being ketchup, mustard, barbeque sauce, and mayonnaise; custard," in International Class 30:

- Registration No. 2638407 for the mark COTTON CANDY and design reproduced below for "bubble gum," in International Class 30; and



- Registration No. 2976094 for the mark COTTON CANDY (standard characters) for "ice cream," in International Class 30.

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences

in the essential characteristics of the goods and differences in the marks.” *In re Embiid*, 2021 USPQ2d 577, at \*10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

For the sake of economy, we will confine our analysis to the issue of likelihood of confusion between Applicant’s mark and the mark in Registration No. 2976094 on the Principal Register for the mark COTTON CANDY (standard characters) for “ice cream,” in International Class 30. Of the two cited marks, this one is the most similar to Applicant’s mark and is registered for goods that are most similar to Applicant’s goods. If the refusal cannot be affirmed on the basis of this registered mark, it cannot be affirmed on the basis of the other cited marks. See *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3 (TTAB 2020); *North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

**A. The similarity or dissimilarity of the marks**

Applicant’s mark COTTON CANDY in standard characters is identical to the registered mark COTTON CANDY in standard characters for “ice cream.”

Applicant, in its brief, does not argue that the marks are not similar.

**B. The similarity or dissimilarity and nature of the goods**

As noted above, Registration No. 2976094 is for the mark COTTON CANDY (standard characters) for “ice cream.” Applicant is seeking to register its COTTON CANDY mark for, inter alia, sherbet, sorbet, edible ices, and custard.

THE RANDOM HOUSE UNABRIDGED DICTIONARY (2022) posted on Dictionary.com (accessed December 1, 2022) provides the following definitions:

- Ice Cream is “a frozen food containing cream or milk and butterfat, sugar, flavoring, and sometimes eggs”;
- Sherbet is “a frozen dessert made with sweetened fruit juice or purees, typically containing milk or cream, with egg white or gelatin often added”; and
- Sorbet is “a frozen dairy-free dessert made with sweetened fruit juice or purée.”

The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed December 1, 2022) defines “ices,” inter alia, as “a frozen dessert containing a flavoring (such as fruit juice).”

The ENCYCLOPAEDIA BRITANNICA explains the difference between the above-noted frozen desserts as follows:

**Ice cream and other frozen desserts**

The principal frozen desserts are ice cream, frozen custard, ice milk, frozen yogurt, sherbet, and water ices. Ice cream has the highest fat content, ranging from 10 to 20 percent. Frozen custard, or French ice cream, is basically the same formula as ice cream but contains added eggs or egg solids (usually 1.4 percent by weight).<sup>38</sup> Ice milk may be more

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<sup>38</sup> “Ice Cream,” Encyclopaedia Britannica identifies “frozen custard” as a type of ice cream.

commonly called “light” or “reduced-fat” ice cream. It contains between 2 and 7 percent fat and at least 11 percent total milk solids.

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Sherbets contain relatively small quantities of milk products. Most standards require between 1 and 2 percent milk fat and between 2 and 5 percent total milk solids. Sherbet contains considerably more sugar and less air than ice cream (the target overrun is 30 to 40 percent), and therefore it is heavier and often contains more calories per serving. Water ices are similar to sherbet, but they contain no milk solids and have a target overrun of 20 to 30 percent.

“Ice Cream and other frozen desserts,” ENCYCLOPAEDIA BRITANNICA (britannica.com) (accessed December 1, 2022).<sup>39</sup>

“Sorbet vs. Sherbet vs. Ice Cream: What’s the Difference,” an article posted on the Baskin Robbins website (baskinrobbins.com) (April 27, 2021) explains that sorbets or ices are the oldest ice cream products.<sup>40</sup> They are “essentially flavoring and frozen water.”<sup>41</sup> Ice cream is at the other end of the spectrum because it includes dairy products and typically 10-16% fat.<sup>42</sup> Sherbets fall in between sorbet and ice cream inasmuch as it has only 1-2% dairy ingredients.<sup>43</sup>

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<sup>39</sup> The Board may take judicial notice of information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works).

<sup>40</sup> November 24, 2021 Office Action (TSDR 16).

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at TSDR 17.

The Examining Attorney submitted webpages from the Baskin Robbins website (baskinrobbins.com) displaying the Baskin Robbins mark, reproduced below, to identify ice cream, sherbet, and sorbet.<sup>44</sup>



The Examining Attorney also submitted a webpage from the Kroger website (kroger.com) advertising the sale of Dreyer's Old Fashioned Vanilla Frozen Custard<sup>45</sup> and a webpage from the Dreyer's website (icecream.com/us/en/brands/dreyers/products) advertising Dreyer's ice cream<sup>46</sup> to show that Dreyer's sells both custard and ice cream under the Dreyer's house mark.

While Applicant concedes that “it is accurate that one manufacturer or provider could possibly offer ice cream as well as sorbet or sherbet,” it argues that “each are unique and would be chosen by a consumer for unique reasons.”<sup>47</sup> Thus, “many consumers are careful in their selection of frozen dessert items, choosing – for example – sorbet over sherbet or ice cream, or sherbet over ice cream.”<sup>48</sup>

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<sup>44</sup> November 24, 2021 Office Action (TSDR13-15).

<sup>45</sup> November 24, 2021 Office Action (TSDR 19).

<sup>46</sup> November 24, 2021 Office Action (TSDR 20).

<sup>47</sup> Applicant's Brief, p. 18 (4 TTABVUE 19).

<sup>48</sup> *Id.*

The issue in this appeal is not whether purchasers would confuse the parties' goods (ice cream versus sherbet, sorbet and edible ices), but rather whether there is a likelihood of confusion as to the source of these goods. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018) (“the test is not whether consumers would be likely to confuse these goods, but rather whether they would be likely to be confused as to their source.”); *In re Cook Med. Tech. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012).

Ice cream, sherbet, and sorbet are all frozen desserts and at least one manufacturer (Baskin Robbins) offers all three. In addition, Dreyer's offers frozen custard and ice cream. Where, as here, the marks are identical, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993) (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.”); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is only necessary that there be a viable relationship between the two to support a finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Applicant also contends that each of its products “will be flavored like or include its same-named COTTON CANDY grapes, either sherbet or sorbet – which are each distinct from ice cream....”<sup>49</sup> However, we must consider the goods as they are described in the application and registration which, as noted above, do not associate the goods with the flavor of Applicant’s grapes. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”); *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”).

We also do not read limitations into the identification of goods. *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have

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<sup>49</sup> Applicant’s Brief, p. 18 (4 TTABVUE 19).

no authority to read any restrictions or limitations into the registrant's description of goods."). Therefore, we must presume that Applicant's sorbet, sherbet, and custard include all types of sorbet, sherbet, and custard (including frozen) regardless of whether they are associated with Applicant's grapes.

We find Applicant's sorbet, sherbet, and custard are related to Registrant's ice cream. Under this *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of goods. It is sufficient for a refusal based on likelihood of confusion that we find any item encompassed by the identification of goods in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3-4 (TTAB 2020); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

### **C. Conclusion**

Because the marks are identical and the goods are related, we find that Applicant's mark COTTON CANDY for "confectionary, namely, chewy sweets, chocolate confections, boiled confectionery made of sugar, hard confectionery made of sugar, jelly confections, lollipops; sherbet and sour lollies, toffee; sorbet; edible ices; seasonings; spices; sauces; condiments for food and drink being ketchup, mustard, barbeque sauce, and mayonnaise; custard" is likely to cause confusion with the mark COTTON CANDY in Registration No. 2976094 for ice cream.<sup>50</sup>

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<sup>50</sup> Because we have found Applicant's mark is likely to cause confusion with the registered mark COTTON CANDY for ice cream, we need not reach the merits of the Section 2(d) refusal

**Decision:** We affirm the refusal to register Applicant's mark COTTON CANDY under Section 2(e)(1) of the Trademark Act for the goods in Classes 29, 30, 32 and 33.

We affirm the refusal to register Applicant's mark COTTON CANDY in Class 30 under Section 2(d) of the Trademark Act.

**Wolfson, Administrative Trademark Judge, concurring:**

I concur with the majority's ultimate conclusion that Applicant has failed to prove that its mark is suggestive rather than merely descriptive. However, I believe the majority is being overly strict in refusing to accept that Applicant is asserting a claim under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Because I find Applicant is making a claim under Section 2(f) as an alternative means for the Board to consider its mark registrable, I also analyze whether Applicant's mark COTTON CANDY has acquired distinctiveness for the applied-for goods.

As the majority notes, Applicant argues in its Request for Reconsideration that it owns registrations for the mark COTTON CANDY and that "[t]hese prior registrations and Applicant's use of the COTTON CANDY mark in commerce for over a decade have resulted in Applicant's COTTON CANDY mark acquiring distinctiveness." Applicant maintains these arguments in its brief:

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vis-à-vis the registered mark COTTON CANDY for bubble gum. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (Board determined likelihood of confusion with respect to only one of the two cited registrations); *In re Davey Prods, Pty Ltd.*, 92 USPQ2d 1198, 1201-02 (TTAB 2009) (same); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1702 (TTAB 2003) (affirmance of requirement for product information was sufficient basis to refuse registration; Board declined to reach merits of refusal based on mere descriptiveness because applicant's failure to submit required information hindered Board's ability to assess the latter refusal).

Applicant is a breeder of fruit, specifically of table grapes and cherries, and markets the fruit breeds under various names including COTTON CANDY. ...

Applicant owns many U.S. trademark registrations for its live plants and fresh fruit, including but not limited to registrations for COTTON CANDY for live plants, namely, grape vines (RN 4007539), in use since at least as early as 2010 and COTTON CANDY for fruits, namely fresh grapes (RN 4109691) used, in use since at least as early as 2011. **These prior registrations and Applicant's use of the COTTON CANDY mark in commerce for over a decade have resulted in Applicant's COTTON CANDY trademark acquiring distinctiveness.** ...

Applicant respectfully submits that this is an **additional factor** which illustrates how the end consumer who is familiar with the same-named fresh fruit will recognize the brand in the licensed products and to understand Applicant as the source of those products and thus that Applicant's use of its COTTON CANDY mark is not merely descriptive.

Appeal brief, 4 TTABVUE 12-13 (emphasis added).

The majority dismisses Applicant's arguments as merely a "general claim" and extrapolates that Applicant's arguments of acquired distinctiveness relate to the goods of its registrations only.<sup>51</sup> The majority also interprets Applicant's arguments regarding its intent to engage in "ingredient/flavor branding"<sup>52</sup> as supporting an argument that the mark is suggestive only. Such narrow reading of Applicant's arguments was not intended by Applicant. This Board should not demand such literal

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<sup>51</sup> A meaningless admission if so, because the registrations are registered on the Principal Register without a claim to acquired distinctiveness.

<sup>52</sup> Described by Applicant as "ultimately allow[ing] the end consumer who is familiar with the same-named fresh fruit to recognize the brand in the licensed products and recognize the mark as a source indicator." 4 TTABVUE 13.

conformity as to insist that Applicant use a specific formula of “magic words” in order to claim the benefit of Section 2(f).

The majority also relies on Applicant’s counsel’s response to the question from the bench during oral hearing asking whether Section 2(f) was invoked. Counsel apparently misunderstood the implication of the question, because she answered it by referring to the requirement, which the application does not meet, of being use-based (“no, because the application is intent-to-use”). Upon further questioning, however, she confirmed Applicant’s reliance on its prior registrations to show acquired distinctiveness of the mark for the involved goods.<sup>53</sup> This is another prong under Section 2(f), and counsel’s misunderstanding the question as referring only to the first prong should not be fatal to the claim.

Whether a mark is merely descriptive and whether it has acquired distinctiveness are separate considerations under the Trademark Act. It is not enough simply to assume that acquired distinctiveness obviates the descriptiveness refusal. To overcome a mere descriptiveness refusal, an applicant must either prove its mark is not merely descriptive or must prove that its mark has acquired distinctiveness under Section 2(f). Based on the statements made by Applicant during prosecution and in its brief, and as confirmed by counsel’s statements at the oral hearing, I construe Applicant’s argument that we accept its prior registrations and use as evidence of distinctiveness as a sufficient claim of acquired distinctiveness in the alternative.

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<sup>53</sup> Indeed, as discussed more fully below, the Examining Attorney also understood Applicant to be claiming distinctiveness based on its prior registrations; at the oral hearing, he said that was why he allowed the child application.

Trademark Rule 2.41(a), 37 C. F. R. § 2.41(a), makes clear that such a claim is encompassed under Section 2(f).

§ 2.41 Proof of distinctiveness under section 2(f).

(a) *For a trademark or service mark—(1) Ownership of prior registration(s).* In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.<sup>54</sup>

The fact that Applicant's application is filed on an intent-to-use basis does not eliminate Applicant's right to claim Section 2(f) in the alternative. The Court of Appeals for the Federal Circuit explained how an applicant of a mark not yet in use may still claim the benefits of Section 2(f). In *In re Dial-A-Mattress Operating Corp.*, the court reversed an examining attorney's rejection of the applicant's intent-to-use based application despite finding the mark, 1-888-M-A-T-R-E-S-S, descriptive of the relevant services. The court found that the mark had "acquired prima facie distinctiveness as the legal equivalent of one of Dial-A-Mattress' previously-registered marks."

Because by definition registration based on acquired distinctiveness requires prior use of the mark, an applicant who has applied to register a mark based on its intent to use the mark ordinarily will not claim acquired

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<sup>54</sup> As with a use-based application, there are three methods for establishing that a mark has acquired distinctiveness for goods sufficiently similar or related to those identified in the intent-to-use application. These are: ownership of prior registrations, five-year substantially exclusive and continuous use in commerce, or other appropriate evidence of distinctiveness. 37 C.F.R. § 2.41(a)(1-3). Here, Applicant relies primarily upon its ownership of prior registrations but also submitted unverified statements that it has used the mark for over a decade on the goods for which it holds registrations.

distinctiveness unless it seeks to show that it has used the mark since the date of its application and the mark has acquired secondary meaning. However, Trademark Rule 2.41[a] provides that “[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness.” ... Thus, an applicant can establish acquired distinctiveness in an intent-to-use application where it can show that “same mark” acquired distinctiveness for related goods or services, and that this acquired distinctiveness will transfer to the goods or services specified in the application when the mark is used in connection with them.

*In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); *see also In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (“To satisfy this element, applicant must show the extent to which the goods and/or services in the intent-to-use application are related to the goods and/or services in connection with which the mark is distinctive, and that there is a strong likelihood that the mark’s established trademark function will transfer to the related goods and/or services when use in commerce occurs.”); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) 1212.09(a) (intent-to-use applicant who can establish prior registration of the mark for sufficiently related goods may transfer the “mark’s established trademark function” to the goods and services in the intent-to-use application when use in commerce begins) (quoting *In re Rogers*, 53 USPQ2d 1741, 1745 (TTAB 1999)).

To establish a transfer of distinctiveness from Applicant’s prior registrations, Applicant needs to meet the following requirements: (1) its registrations must be active Principal Register registrations; (2) the mark in each must be essentially the same as the mark in its application; and (3) the goods must be sufficiently related. *In re Olin Corp.*, 124 USPQ2d 1327, 1333 (TTAB 2017). Applicant has made its active,

prior, Principal Register registrations of record and the mark in each registration is the identical COTTON CANDY mark of the application. Thus, whether a transfer of distinctiveness will occur turns on whether the applied-for goods are by their nature sufficiently similar to the registered goods, which in this case are grape vines and fresh grapes.

As enunciated by the Board in *Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1770 (TTAB 2007), “in cases where the identifications of goods alone reveal sufficient facts about the respective goods from which a conclusion, not based on mere conjecture, as to the relationship between the goods may be made,” an applicant is not required to present extrinsic evidence establishing the relationship between the respective goods. In *Kellogg*, the applicant claimed acquired distinctiveness of the mark CINNAMON TOAST CRUNCH for a “cereal derived ready-to-eat food bar” based on its ownership of two incontestable registrations for the mark for breakfast cereal together with 16 years of use of the mark in commerce in connection with breakfast cereal. The applicant had not commenced use of its mark on food bars. The applicant did not file any evidence in the case to establish a relationship between the respective goods. Nonetheless, the court found there to be a “close relationship between the goods [that] is self-evident from the respective identifications of goods and there is no requirement for the submission of extrinsic evidence to establish that the goods are related in this case.” *Kellogg*, 82 USPQ2d at 1771.

The Board in *Kellogg* cited with approval the *Dial-A-Mattress* case, “where, without reference to any evidence, the Court found a ‘close relationship’ between

‘retail outlet services and retail store services featuring mattresses’ and ‘telephone shop-at-home retail services in the field of mattresses,’” noting that “the latter can be considered a subset of the former.” *Id.*; see also *In re Olin Corp.*, 124 USPQ2d at 1335 (finding it to be “self-evident from the identifications that Applicant’s prior registrations [cartridges, high explosives; non-ferrous metals and alloys; ammunition and shotguns] are for goods unrelated to those identified in the application” [chemicals for industrial purposes and resins]); *In re Binion*, 93 USPQ 2d at 1539 (finding casino gaming services; hotel and bar services to be “identical or closely related” to casino, hotel, restaurant and bar services. “[T]hus, the applicant has met the second requirement for showing that a mark in an intent-to-use application has acquired distinctiveness.”); cf. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (holding under Section 2(d) likelihood of confusion that the respective identifications of goods were, themselves, evidence as to the relatedness of the parties’ goods and extrinsic evidence of relatedness was not per se required).

During prosecution, the Examining Attorney allowed Applicant to divide the application. The child application is proceeding to registration for “Fresh fruits and vegetables, not being sweet corn; live plants, namely, fresh grape vines; parts of live plants not being sweet corn.”<sup>55</sup> At the oral hearing, the Examining Attorney

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<sup>55</sup> Serial No. 88984471, filed November 30, 2019 with a claim of ownership of Reg. Nos. 4007539 and 4109691; published for opposition November 1, 2022.

confirmed his reasoning for not refusing the application in Class 31, as explained in the Final Office Action:

Applicant argues that that [sic] Applicant owns the registrations for “COTTON CANDY” for live plants, namely grape vines, and also fruits, namely fresh grapes. The Examiner notes that due to these two prior incontestable registrations, Applicant was not refused in International Class 031. As in *Park ‘N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327 (1985), the Supreme Court held that the owner of a registered mark may rely on incontestability to enjoin infringement, and that an incontestable registration, therefore, cannot be challenged on the ground that the mark is merely descriptive. Moreover, in *In re Am. Sail Training Ass’n*, 230 USPQ 879 (TTAB 1986), the Trademark Trial and Appeal Board held that an examining attorney could not require a disclaimer of “TALL SHIPS” in an application for registration of the mark RETURN OF THE TALL SHIPS, where the Applicant owned an incontestable registration for the mark TALL SHIPS for the identical services. This would be a collateral attack on an incontestable registration. However, this applies only where both the marks and the goods or services are identical, and the identical part of the applied-for mark would not be considered generic. The Board noted that the matter required to be disclaimed was “identical to the subject matter of Applicant’s incontestable registration,” and that “the services described in Applicant’s application are identical to those recited in the prior incontestable registration.” *Id.* at 880. Here, however, aside from International Class 031, Applicant seeks to register goods that are not identical or identical in part. As such, the incontestable registrations are not persuasive regarding the applied-for goods in International Classes 029, 030, 032, and 033.

November 24, 2021, Final Office Action, TSDR 10.<sup>56</sup>

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<sup>56</sup> The goods in the child application include fresh grape vines, but these are the only goods that could be considered identical to those of the registration. The majority points to the Examining Attorney’s statement contained in the November 24, 2021 Final Office Action as supporting its conclusion that he believed he was estopped from refusing registration for the

If there is not a “self-evident” relationship between the goods, the transfer of distinctiveness can still be found if supported by sufficient evidence of record. Applicant did not submit evidence in support of its statement that it has used its mark with respect to grape vines and fresh grapes or that any of the goods in its application are related to grape vines or fresh grapes. Comporting with the Examining Attorney’s Action in accepting “fresh fruits and vegetables, not being sweet corn” as sufficiently related to grape vines and fresh grapes as to find self-evident a relationship between them, it is my view that a similarly self-evident relationship could be found with respect to “preserved, dried and cooked fruit; jellies, jams and compotes” in International Class 29; and “fruit beverages and fruit juices; other non-alcoholic preparations for making beverages, namely, non-alcoholic fruit extracts used in the preparation of beverages” in Class 32. I do not however find an inherent relationship between any of the other goods, and without evidence would not have allowed other goods to be registered. “[B]y the very nature of the inquiry, Section 1(b) applicants face a heavy burden in establishing that their mark will acquire distinctiveness when use commences. Accordingly, the required showing for acquired distinctiveness to ‘transfer’ to new products is a rigorous one.” *In re Olin Corp.*, 124 USPQ2d at 1335.

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entire Class 31 goods. However, the statement that “aside from International Class 031, applicant seeks to register goods that are not identical or identical in part” must be read in conjunction with the statement that follows, which is that “[a]s such, the incontestable registrations are not persuasive regarding the applied-for goods in International Classes 029, 030, 032, and 033.” In other words, the Examining Attorney recognized that Applicant’s right to register its mark for the Class 31 goods derived from the transfer of distinctiveness of the mark in its prior registrations.

For these reasons, I would find Applicant to have made a claim under Section 2(f) and that a relationship between “live plants, namely, grape vines” and “fruits, namely fresh grapes” and “preserved, dried and cooked fruit; jellies, jams and compotes; and “fruit beverages and fruit juices; other non-alcoholic preparations for making beverages, namely, non-alcoholic fruit extracts used in the preparation of beverages” is self-evident.